

REMARKS

Rejections for Obviousness-Type Double Patenting

All of the pending claims stand rejected on six separate grounds for obviousness-type double patenting. Applicants respectfully traverse each of the rejections.

For obviousness-type double patenting to apply, the differences between the claimed invention and the patented invention must be obvious. *See In re Vogel*, 422 F.2d 438, 441 (CCPA 1970). The examiner bears the initial burden of establishing a *prima facie* case of obviousness-type double patenting, *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); there must be a reasoned, fact-based explanation supported by evidence of record to justify a conclusion that the claimed invention is an obvious variant of the patented claims. *Ex parte Whalen II*, Appeal 2007-4423 (BPAI Jul. 23, 2008) (precedential opinion). The examiner may use the patent's specification as a dictionary to determine the meaning of terms in the patent's claim, but not as though it were prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1281 (Fed. Cir. 1992).

For the reasons detailed in the following paragraphs, Applicants assert that the double patenting rejections fail to provide a *prima facie* case of obviousness-type double patenting because not every difference between the asserted patent claims and the present claims has been identified and a reasoned, fact-based explanation of why the difference is obvious has not been provided.

I.

Claims 1-7, 9, and 10 stand rejected for obviousness-type double patenting over claim 47 of US Patent 6,013,340 in view of Lee et al., US Patent 5,605,961. Applicants traverse this rejection and request reconsideration of the claims.

The following differences are unaccounted for:

a gas-filled cushioning device. The Office Action makes no argument that this is an obvious variant of claim 47.

a multi-layer film. The Office Action points to claims 50-52, but this is an impermissible use of the patent specification as prior art, not as a dictionary for explaining patent terms. Nothing in claim 47 makes this difference obvious.

a second, outer layer comprising a flexible resilient elastomeric thermoplastic material.

Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 47.

permitting an inward diffusion pumping of at least one mobile gas constituent. Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 47.

wherein hydrogen bonding occurs along a segment of the film between the first layer and the second layer. Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 47.

In addition, the Lee et al. patent is nonanalogous art. The Lee patent concerns molding compositions in which a polyurethane and a polyolefin are compatibilized by adding a reaction product of a polyamide and modified polyolefin. The Lee patent is not in the field of the present invention, cushioning devices. Nor is the Lee patent relevant to solving any problem faced by Applicants, as Applicants' cushioning device and multi-layer film thereof do not include either a polyolefin or a reaction product of a polyamide and modified polyolefin.

Furthermore, even were the Lee patent proper prior art, there would be no reason to combine it with claim 47. The Office Action asserts that one would turn to the Lee patent because "the thermoplastic polyurethane formed . . . is a well known composition for formation of a

thermoplastic molding composition.” OA at page 4. This does not demonstrate, however, that it is a well-known component of a membrane of according to claim 47. It would really depend on the properties it would bring to sealed, inflated, flexible membrane of claim 47, and the Lee patent simply does not speak to that.

Finally, the further limitations of at least claims 3-5 and 10 are absent from claim 47 and have not been shown to be obvious variants of claim 47.

For all of these reasons, Applicants respectfully request reconsideration of claims 1-7, 9, and 10

II.

Claims 1-7, 9, and 10 stand rejected for obviousness-type double patenting over claim 10 of US Patent 6,203,868 in view of Lee et al., US Patent 5,605,961. Applicants traverse this rejection and request reconsideration of the claims.

The following differences are unaccounted for:

a gas-filled cushioning device. The Office Action makes no argument that this is an obvious variant of claim 10, a barrier membrane.

a multi-layer film. The Office Action points to claim 11, but this is an impermissible use of the patent specification as prior art, not as a dictionary for explaining patent terms. Nothing in claim 10 makes this difference obvious.

a second, outer layer comprising a flexible resilient elastomeric thermoplastic material.

Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 10.

permitting an inward diffusion pumping of at least one mobile gas constituent. Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 10.

wherein hydrogen bonding occurs along a segment of the film between the first layer and the second layer. Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 10.

In addition, the Lee et al. patent is nonanalogous art. The Lee patent concerns molding compositions in which a polyurethane and a polyolefin are compatibilized by adding a reaction product of a polyamide and modified polyolefin. The Lee patent is not in the field of the present invention, cushioning devices. Nor is the Lee patent relevant to solving any problem faced by Applicants, as Applicants' cushioning device and multi-layer film thereof do not include either a polyolefin or a reaction product of a polyamide and modified polyolefin.

Furthermore, even were the Lee patent proper prior art, there would be no reason to combine it with claim 10. The Office Action asserts that one would turn to the Lee patent because "the thermoplastic polyurethane formed . . . is a well known composition for formation of a thermoplastic molding composition." OA at page 5. As in the above rejection, this does not demonstrate that it is a well-known component of a membrane as in claim 10, nor provide any reason to include it in the membrane of claim 10.

Finally, the further limitations of at least claims 3-5 and 10 are absent from claim 10 and have not been shown to be obvious variants of claim 10.

For all of these reasons, Applicants respectfully request reconsideration of claims 1-7, 9, and

III.

Claims 1-7, 9, and 10 stand rejected for obviousness-type double patenting over claims 9 and 20 of US Patent 6,599,597 in view of Lee et al., US Patent 5,605,961. Applicants traverse this rejection and request reconsideration of the claims. This rejection is moot in view of the terminal disclaimer filed February 23, 2006 for this application over 6,599,597.

IV.

Claims 1-7, 9, and 10 stand rejected for obviousness-type double patenting over claim 22 of US Patent 6,652,940 in view of Lee et al., US Patent 5,605,961. Applicants traverse this rejection and request reconsideration of the claims.

The following differences are unaccounted for:

a gas-filled cushioning device. The Office Action states that the container is “permanently sealed,” but this is not a limitation present in claim 22 or its underlying independent claim 1, which provides only that the container is “substantially closed.” The Office Action further refers to claims 26 and 27, but this is an impermissible use of the specification as prior art. In addition, there is no evidence that either of the devices of claim 26 or claim 27 would be considered a “cushioning device.”

a multi-layer film. The Office Action points to claim 23 of US 6,652,940, but this is an impermissible use of the patent specification as prior art, not as a dictionary for explaining patent terms. Nothing in claim 22 makes this difference obvious.

a second, outer layer comprising a flexible resilient elastomeric thermoplastic material.

Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 22.

permitting an inward diffusion pumping of at least one mobile gas constituent. Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 22.

wherein hydrogen bonding occurs along a segment of the film between the first layer and the second layer. Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 22.

In addition, the Lee et al. patent is nonanalogous art. The Lee patent concerns molding compositions in which a polyurethane and a polyolefin are compatibilized by adding a reaction product of a polyamide and modified polyolefin. The Lee patent is not in the field of the present invention, cushioning devices. Nor is the Lee patent relevant to solving any problem faced by Applicants, as Applicants' cushioning device and multi-layer film thereof do not include either a polyolefin or a reaction product of a polyamide and modified polyolefin.

Furthermore, even were the Lee patent proper prior art, there would be no reason to combine it with claim 22. The Office Action asserts that one would turn to the Lee patent because "the thermoplastic polyurethane formed . . . is a well known composition for formation of a thermoplastic molding composition." OA at page 8. As in the above rejections, however, this does not demonstrate that it is a well-known component of a substantially closed container as in claim 22, nor provide any reason to include it in the container of claim 22.

Finally, the further limitations of at least claims 3-5 and 10 are absent from claim 22 and have not been shown to be obvious variants of claim 22.

For all of these reasons, Applicants respectfully request reconsideration of claims 1-7, 9, and

10

V.

Claims 1-7, 9, and 10 stand rejected for obviousness-type double patenting over claim 21 of US Patent 6,692,803 in view of Lee et al., US Patent 5,605,961. Applicants traverse this rejection and request reconsideration of the claims.

The following differences are unaccounted for:

a multi-layer film. The Office Action points to claim 22 of US 6,652,940, but this is an impermissible use of the patent specification as prior art, not as a dictionary for explaining patent terms. Nothing in claim 21 makes this difference obvious.

a second, outer layer comprising a flexible resilient elastomeric thermoplastic material.

Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 21.

permitting an inward diffusion pumping of at least one mobile gas constituent. Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 21.

wherein hydrogen bonding occurs along a segment of the film between the first layer and the second layer. Nothing in the Office Action supports finding this claim limitation to be an obvious variant of claim 21.

In addition, the Lee et al. patent is nonanalogous art. The Lee patent concerns molding compositions in which a polyurethane and a polyolefin are compatibilized by adding a reaction product of a polyamide and modified polyolefin. The Lee patent is not in the field of the present invention, cushioning devices. Nor is the Lee patent relevant to solving any problem faced by Applicants, as Applicants' cushioning device and multi-layer film thereof do not include either a polyolefin or a reaction product of a polyamide and modified polyolefin.

Furthermore, even were the Lee patent proper prior art, there would be no reason to combine it with claim 21. The Office Action asserts that one would turn to the Lee patent because "the

thermoplastic polyurethane formed . . . is a well known composition for formation of a thermoplastic molding composition.” OA at page 9. As in the above rejections, however, this does not demonstrate that it is a well-known component of a cushioning device as in claim 21, nor provide any reason to include it in the cushioning device of claim 21.

Finally, the further limitations of at least claims 3-7 and 10 are absent from claim 22 and have not been shown to be obvious variants of claim 21.

For all of these reasons, Applicants respectfully request reconsideration of claims 1-7, 9, and 10

Vi.

Claims 1-7, 9, and 10 stand rejected for obviousness-type double patenting over claim 7 of US Patent 6,730,379 in view of Lee et al., US Patent 5,605,961. Applicants traverse this rejection and request reconsideration of the claims.

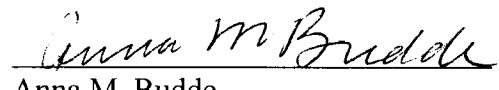
This rejection is improper as it has already been determined in US Pat. Appl. 09/170,790, of which both US Patent 6,730,379 and the present application are divisionals, that the presently claimed invention is not an obvious variant of the invention claimed in US Patent 6,730,379.

Conclusion

It is believed that all of the stated grounds of rejection and objection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections and objections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable

consideration of this amendment is respectfully requested. The Examiner is invited to telephone the undersigned if it would be helpful for resolving any issue.

Respectfully submitted,


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